

Patent  
Docket No. 112171-004.UTL  
(formerly TARINFO.016A)

list can be a mailing list, a telephone list or an email list, for example. In one embodiment, the selected criteria include a geographic area definition and a classification with a threshold value associated with the classification. For example the contact list can be generated based upon an arbitrary geographic definition such as a point and radius or polygon. All households within that geographic area definition which meet or exceed the threshold value for the classification are then included in the contact list. Because the system and method are real-time and interactive, if insufficient numbers of contacts are generated based upon the criteria, the criteria can be modified to generate a list of contacts of a desired size.

Bates, on the other hand, describes a system and method to "implement various intelligent contact management operations to improve the productivity of users of electronic messaging systems and the like." (Bates, Abstract.) Bates describes features such as an intelligent name look-up which selects "a favored user" from a subset of users in a contact database that meet a pre-determined search criteria based upon a pre-determined affinity criteria. In addition, Bates describes the automated addition of new entries to a contact database in response to a pre-determined number of contacts from a new entity. (Bates, Abstract.) The elements of Bates pointed to in the Office Action as corresponding to the limitations of the claims do not teach or make obvious the claimed invention.

For example, referring to independent claim 57, the Office Action pointed to column 9, lines 5-30 of Bates as corresponding to limitation of "interactively generating a list specification in real-time, comprising: interactively specifying a geographically defined area for which a contact list is desired including receiving user input." However, lines 5-30 of column 9 of Bates merely describes a data structure (user entry 80) and its use of pointers to create linked lists for electronic messaging groups associated with that user. There is no description in that section of Bates of interactively generating a list specification in real-time, nor is there any description of interactively specifying a geographically defined area for which a contact list is desired. In addition, nowhere else in Bates is there a teaching or suggestion of interactively generating a list specification in real-time including specifying a geographically defined area by user input for which a contact list is desired.

Further, with regard to the claim limitation of "transmitting the list specification over a computer network to a server having a memory," the Office Action points to column 10, line 7-

Patent  
Docket No. 112171-004.UTL  
(formerly TARINFO.016A)

12 of Bates. However, that section of Bates has nothing to do with building a contact list and certainly does not describe transmitting the list specification over the computer network to a server. Specifically, lines 7-12, column 10 of Bates describe the "send/receive message" event. That event is described as being "generally initiated in response to a user request to send any pending messages in the user's outbox and retrieve from the server any messages sent by other users to that particular user." This appears to be no more than a description of sending and receiving emails. Clearly this does not teach or suggest transmitting the list specification over the computer network to a server. It does not even teach or suggest transmitting the user entry 80 of Bates (the element in Bates which was pointed to as corresponding to the "list specification") over a computer network to a server.

The next element of claim 57 is "building the contact list on the server in real-time based on the list specification." In the Office Action column 11, lines 1-14 and column 18, lines 58 through column 19, line 14 were pointed to as corresponding to this element. However, those portions of Bates, and the rest of Bates, do not teach or suggest this element. For example, column 11, lines 1-14 describe the intelligent name look-up function of the Bates system. This function is described by Bates as follows: "Intelligent name look-up consistent with the invention is typically implemented in a search routine, such as perform partial name look-up routine 110 of FIG. 7. With intelligent name look-up, a pre-determined search criteria is utilized to select a subset of users from a contact database. Then, rather than organizing the search results based upon alphabetical ordering, one or more of the users in the subset are favored relative to others based upon a pre-determined affinity criteria so that users having a greater affinity to the local user are highlighted relative to the other users." (Bates, column 10, lines 42-51.) The portion of the description of the intelligent name look-up routine pointed to in the Office Action merely describes the process of modifying the search criteria in connection with a process for intelligent name look-up. The list that is generated by this process is not based upon what was previously identified in the Office Action as corresponding to the claimed "list specification." Therefore this process cannot meet the limitation of building the contact list on the server.

Confusingly, the Office Action also identifies column 18, line 58 through column 19, line 14 as meeting this same element. However, that portion of Bates describes the automatic

Patent  
Docket No. 112171-004.UTL  
(formerly TARINFO.016A)

creation of new electronic messaging groups and appears to be completely unrelated to the intelligent name look-up routine. No explanation is provided in the Office Action of how these two separate routines are related or could be combined. Certainly Bates provides no such teaching. Additionally, the creation of new electronic messaging groups described in column 18 does not use the portions of Bates that were previously identified in the Office Action as corresponding to the "list specification." Therefore the portion of Bates beginning on column 18, line 58 cannot meet the limitation of building the contact list on the server based on the list specification.

It was admitted in the Office Action that Bates does not teach or suggest interactively selecting a product from a plurality of products and a threshold score for the product including receiving user input in connection with interactively generating a list specification in real-time. The Office Action asserts that Kinra "discloses the idea of selecting a product and a value (threshold) for the product (Col. 1, lines 50-61)." The Office Action further asserts that it would have been obvious to one of ordinary skill in the art to modify Bates to incorporate the teachings of Kinra. Applicant respectfully disagrees with that analysis.

Kinra is directed to an automatic method or system for evaluating a software product. (Kinra, column 1, lines 32-39.) Kinra does not appear to have any teachings or suggestions relating to building contact lists as claimed in the present application or to have any relationship to "contact management" as described in Bates.

Because Bates and Kinra are not in the same field of endeavor, Applicant sees no motivation for combining elements of Kinra with elements of Bates. In addition, there is no explanation provided of how the system of Bates could be modified to accept a product and the threshold in connection with generating a list specification. Bates includes no description of such information and expresses no desire or need for such information. Therefore, Applicant respectfully submits that Kinra's description of a software product and its related score cannot properly be combined with Bates.

In addition, Applicant notes that many other elements of the independent and dependent claims are not taught or suggested by the references of record. For example, independent claim 117 describes "receiving user input to specify a location and radius defined area for which a contact list is desired" as part of generating the list specification. None of the references of

Patent  
Docket No. 112171-004.UTL  
(formerly TARINFO.016A)

record teach or discuss a location and radius defined geographic area in connection with the list specification used to generate a contact list.

Similarly, independent claim 129 describes receiving user input to specify a polygon defined area in connection with generating a list specification which is used to build a contact list. None of the references of record teach or describe a polygon defined geographic area in connection with generating a list specification used to build a contact list.

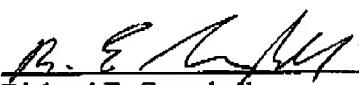
In view of the foregoing, Applicant respectfully submits that a *prima facie* case of obviousness has not been established for the rejected claims. Applicant respectfully requests withdrawal of the rejections under Section 103.

#### CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that all the pending claims are in condition for allowance. The examiner is encouraged to contact the undersigned by telephone if the examiner believes such contact will expedite such allowance of the application.

Respectfully submitted,

Dated: January 14, 2005

By:   
Richard E. Campbell  
Reg. No. 34,790

PROCOPIO, CORY, HARGREAVES & SAVITCH LLP  
530 B Street, Suite 2100  
San Diego, California 92101  
(619) 238-1900  
(619) 235-0398 (Fax)